

REMARKS

The Office Action of June 8, 2006, has been reviewed and considered by the Applicants. No claims have been amended. Claims 6-10, 12-18, 20, 21, 25, and 26 remain pending. Applicants request reconsideration of the Application.

In paragraph 5, claims 6-10, 12-16, 20, 21, 25, and 26 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over the combination of Yuh (U.S. Patent No. 6,177,219), Liu (U.S. Patent No. 6,277,535), Ong '737 (U.S. Patent No. 6,287,737), and Kondo (U.S. Patent No. 4,424,267).

In paragraph 6, claims 6-10, 12-18, 21, 25, and 26 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over the combination of Pai (U.S. Patent No. 5,316,880), Yuh, Liu, and Kondo.

Applicant traverses these rejections together.

Applicants previously argued that Kondo does not teach a resilient overcoat layer as required by the claims. According to the Examiner, Kondo does not explicitly disclose that his insulating silicone resin layer is resilient. On page 11 of the Office Action, the Examiner reasoned that resilient is commonly defined as "elastic, rebounding". According to Kondo, the insulating layer is formed for the purpose of "protecting the photoconductive layer, improving the mechanical strength of the photosensitive member, and bettering the dark decay characteristics of the [imaging] member." Because it improves the mechanical strength of the member, it is reasonable to conclude that Kondo's insulating layer is also resilient. The Examiner also stated that it was Applicants' burden to show otherwise based on *In re Fitzgerald*.

Applicants disagreed with this conclusion. Applicants argued that the three purposes of protection, improvement of mechanical strength, and bettering dark decay characteristics do not inherently require the insulating layer to be resilient. Kondo did not appear to teach that the insulating layer is made mechanically stronger by making it easier to bend. Thus, it is not reasonable to assume that Kondo's insulating layer is resilient. Therefore, the instant claim 10 is not obvious because not all claim limitations are taught. MPEP § 2143.03.

In the current Office Action, the Examiner stated that these assertions were merely attorney argument. The Examiner also added that it appeared improvement in mechanical strength would include resistance to mechanical impacts, which would include being "elastic, rebounding". The Examiner again stated that Applicants had not provided any objective evidence to show that the Kondo insulating silicone resin overcoat is not resilient.

In response, Applicants again argue this point. Applicants agree that Kondo teaches three purposes for using an insulating layer - protection, improvement of mechanical strength, and bettering dark decay characteristics. These purposes are results, though. They do not inherently require the insulating layer to be resilient. The insulating silicone resin overcoat of Kondo is a means for achieving the results. Again, the means does not inherently require the insulating layer to be resilient. Again, there are many means for improving mechanical strength which do not require resilience. For example, U.S. Patent No. 3,687,072 discloses a rigid drum for use in an imaging member having a hard tough insulating layer. U.S. Patent Nos. 5,162,183 and 5,096,796 also disclose hard silicone overcoat layers in imaging members. In these patents, the overcoat / insulating layer is hard; this provides protection and improves mechanical strength without being resilient. Applicants submit that Kondo cannot teach a resilient insulating layer because he makes absolutely no teaching about resilience (or hardness) of the layer.

These statements are not merely attorney argument because they point out defects in the Examiner's reasoning based on evidence of record (Kondo, as well as the patents cited herein). If they are mere argument, then the same objection should apply to the Examiner's reasoning because Kondo does not discuss this property at all.

The newly cited patents should be considered objective evidence that silicone insulating layers do not need to be resilient. The possibility that Kondo's layer may be resilient is not sufficient to establish its inherency. See MPEP § 2112(IV); *In re Rijckaert*. Applicants have rebutted with objective evidence above. If the Examiner requires a showing that Kondo's specific layer is not resilient, this may be impossible because it appears that the Shinetsu X-12-917 silicone resin used by Kondo is no longer available.

Applicants believe that these remarks address the Examiner's reasons for rejection.

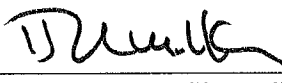
CONCLUSION

For those reasons, all pending claims (6-10, 12-18, 20, 21, 25, and 26) are believed to be in a condition for allowance. In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY SHARPE LLP

January 4, 2007
Date


Richard M. Klein (Reg. No. 33,000)
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582